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NEIFELD IP LAW, PC			ALVAREZ, RAQUEL	
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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* ERIC N. WILLIAMS, J. MICHAEL ERICKSON, and  
KELLIE KATHERINE DOLAN

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Appeal No. 2007-4393  
Application No. 09/826,814  
Technology Center 3600

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Decided: February 27, 2008

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Before TERRY J. OWENS, STEVEN D. A. McCARTHY, and  
BIBHU R. MOHANTY, *Administrative Patent Judges*.

OWENS, *Administrative Patent Judge*.

DECISION ON APPEAL

The Appellants appeal from a rejection of claims 1-9, 11-25, 43-68, 86-101 and 122. Claims 26-42, 69-85, 102-117, 119-121 and 123-129 stand withdrawn from consideration by the Examiner.<sup>1</sup> Claims 10 and 118 have been canceled.

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<sup>1</sup> The Appellants argue that the Board should judge claims 102, 103 and 119-121 on the same basis as the rejections of their parent claims (Br. 11-12). The Examiner stated in the final rejection mailed July 19, 2005 (pp. 7-8) that claims 102, 103 and 119-121 are withdrawn from consideration as belonging to group II in the restriction requirement mailed September 10, 2004. That group was the nonelected group in the Appellants' October 7, 2004 response to the restriction requirement. The propriety of the Examiner's inclusion of claims 102, 103 and 119-121 in the nonelected group is a petitionable matter, not an appealable matter

## THE INVENTION

The Appellants claim a method and system for providing a promotion to a customer based upon the status of a promotion previously delivered to the customer. Claims 1 and 43 are illustrative:

1. A computer implemented method comprising:

storing in a database a status criteria associated with an initial promotion;

storing in said database at least a first status value associated with said status criteria and a second status value associated with said status criteria, said first status value indicating acceptance of said promotion, and said second status value indicating rejection of said promotion;

delivering said initial promotion to a customer;

determining a status of said initial promotion delivered to said customer using said status criteria associated with said initial promotion;

selecting a related promotion based on said status of said initial promotion delivered to said customer;

delivering said related promotion to said customer;

wherein said step of determining said status of said initial promotion comprises:

storing transaction data in association with said initial promotion, wherein said transaction data includes transaction date that said initial promotion was delivered to said customer;

determining a defined status value for status of said initial promotion corresponding to one of (1) accepted, (2) rejected, and (3) unknown, wherein said determining comprises applying said status criteria to said transaction data; and

storing said defined status value.

43. A computer implemented method comprising:

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and, therefore, is not before us. *See Manual of Patent Examining Procedure* § 1002.02(c)(2) (8<sup>th</sup> ed., rev. 6, September 2007).

storing in a database a status criteria associated with an initial promotion;

storing in said database at least a first status value associated with said status criteria and a second status value associated with said status criteria, said first status value indicating acceptance of said promotion, and said second status value indicating rejection of said promotion;

delivering said initial promotion to a customer;

determining a status of said initial promotion delivered to said customer by monitoring customer transactions at a point of sale (POS) and by using said status criteria associated with said initial promotion;

selecting a related promotion for said customer based on said status of said initial promotion delivered to said customer; and

delivering said related promotion to said customer.

## THE REFERENCE

Walker US 6,848,995 B1 Feb. 1, 2005  
(filed May 15, 2000)

## THE REJECTIONS

The claims stand rejected over Walker as follows: claims 1-5, 7-9, 11-19, 21-25, 43-48, 50-62, 64-68, 86-101 and 122 under 35 U.S.C. § 102(e), and claims 6, 20, 49 and 63 under 35 U.S.C. § 103.<sup>2</sup>

## OPINION

The rejection under 35 U.S.C. § 102(e) is reversed as to claims 1-5, 7-9, 11-19 and 21-25, and affirmed as to claims 43-48, 50-62, 64-68, 86-101 and 122. The rejection under 35 U.S.C. § 103 is reversed as to claims 6 and 20 and affirmed as to claims 49 and 63.

<sup>2</sup> A rejection under 35 U.S.C. § 101 is withdrawn in the Examiner's Answer (Ans. 4).

Rejection under 35 U.S.C. § 102(e)  
of claims 1-5, 7-9, 11-19 and 21-25

The Examiner has the initial burden of establishing a *prima facie* case of anticipation by pointing out where all of the claim limitations appear in a single reference. *See In re Spada*, 911 F.2d 705, 708 (Fed. Cir. 1990); *In re King*, 801 F.2d 1324, 1327 (Fed. Cir. 1986).

Claim 1, which is the only independent claim among claims 1-5, 7-9, 11-19 and 21-25, requires “determining a defined status value for status of said initial promotion corresponding to one of (1) accepted, (2) rejected, and (3) unknown”.

Walker discloses a system for determining a product (goods and/or services) to offer a casino player for free or for a certain price to maximize casino profit with respect to the product (col. 1, ll. 14-16, 40-43; col. 2, l. 61 – col. 3, l. 5). The system comprises a past offer database (305) that includes a result of offer (308) that indicates whether the casino player accepted or rejected the offer (col. 14, ll. 11-24, 41-42; fig. 7). Past offer database 305 can be used to determine, based upon whether the casino player has accepted or rejected previous offers, a product to offer the casino player (col. 14, l. 62 – col. 15, l. 11).

The Appellants argue: “Figure 7 field 308 in Walker lists examples of offer results as either ‘accept’ or ‘reject’. That is, Walker does not disclose or suggest using its data to determine or use a third status value, an ‘unknown’ status value” (Br. 11).

The Examiner argues (Ans. 5):

The Examiner wants to point out that Walker teaches that if the status of the promotion cannot be verified, whether the customer accepted or rejected the offer based on the resulting revenues 309, the player may be asked if the **offer had not be [sic] made** and this information will be used to update the transaction data for the customer (col. 14, lines 43-61) ....

The portion of Walker relied upon by the Examiner discloses:

To determine whether revenues have accrued as a result of an offer rejected by a casino player, the casino may ask the casino player at what time they would have stopped gaming if the offer had not been made. Any revenues accrued after the time can be attributed to the rejected offer [col. 14, ll. 56-61].

Hence, the portion of Walker relied upon by the Examiner pertains to a rejected offer, not to a status that cannot be verified.

The Examiner argues that “in addition before any offer has been ‘accepted’ or ‘rejected’ all the offers will be ‘unknown’ to the system” (Ans. 5).

What the Appellants’ claim 1 requires is determining a defined status value corresponding to one of (1) accepted, (2) rejected and (3) unknown. Even if the status of an offer that has not been accepted or rejected is unknown to the system, the Examiner has not established that the mere fact that the status is unknown indicates that the system has determined a defined status value corresponding to “unknown”.

The Examiner, therefore, has not established a *prima facie* case of anticipation of the inventions claimed in the Appellants’ claim 1 and its dependent claims 2-5, 7-9, 11-19 and 21-25.

Rejection under 35 U.S.C. § 102(e) of  
claims 43-48, 50-62, 64-68, 86, 88-101 and 122

The Appellants do not argue that any claim requirement other than determining a defined status value for a status of “unknown” is missing from Walker (Br. 9-12; Reply Br. 2). Claims 43-48, 50-62, 64-68, 86, 88-101 and 122

do not include that claim requirement. Hence, the Appellant has not convinced us of reversible error in the rejection of those claims.

Rejection under 35 U.S.C. § 103  
of claims 6 and 20

The Examiner does not explain how Walker would have rendered prima facie obvious, to one of skill in the art, the requirement in claim 1 of determining a defined status value for a status of “unknown”. Hence, the Examiner has not established a prima facie case of obviousness of the inventions claimed in the Appellants’ claims 6 and 20 that depend from claim 1.

Rejection under 35 U.S.C. § 103  
of claims 49 and 63

Because the Appellants do not argue that any claim requirement other than determining a defined status value for a status of “unknown” is missing from Walker (Br. 9-12; Reply Br. 2), and because claims 49 and 63 do not include that claim requirement, we are not persuaded of reversible error in the rejection of claims 49 and 63.

Rejection of claim 87 under 35 U.S.C. § 102(e)

Claim 87 recites: “A computer readable medium containing program instructions for executing on a computer system, which when executed by the computer system, cause the computer system to perform the steps in the method recited in any one of claims 1-43.”<sup>3</sup>

Because the Appellants have not persuaded us of reversible error in the rejection of claim 43, the Appellants have not persuaded us of reversible error in

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<sup>3</sup> Thus, claim 87 improperly incorporates the steps in canceled claim 10 and withdrawn claims 26-42.

the rejection of claim 87 to the extent that it incorporates the steps in that claim. Hence, we sustain the rejection of claim 87.

Under 37 C.F.R. § 41.50(c) (2007) we state that the rejection of claim 87 under 35 U.S.C. § 102(e) over Walker can be overcome by amending that claim such that “1-43” reads “1-9 and 11-25”.

#### DECISION

The rejection under 35 U.S.C. § 102(e) over Walker is reversed as to claims 1-5, 7-9, 11-19 and 21-25, and affirmed as to claims 43-48, 50-62, 64-68, 86-101 and 122. The rejection under 35 U.S.C. § 103 over Walker is reversed as to claims 6 and 20 and affirmed as to claims 49 and 63.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

JRG

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